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IN THE

Supreme Court of the United States

OCTOBER TERM, 1975

No. 75-110

BERNARD A. SAKRAIDA,

Petitioner,

v.

AG PRO, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

MOTION FOR LEAVE TO APPEAR AS AMICUS CURIAE AND BRIEF AMICUS CURIAE OF THE BAR ASSOCIATION OF THE DISTRICT OF COLUMBIA

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MOTION BY THE BAR ASSOCIATION OF THE DISTRICT OF COLUMBIA FOR LEAVE TO APPEAR AS AMICUS CURIAE

I.

INTRODUCTION

Amicus, The Bar Association for the District of Columbia, hereby moves for permission to file an *amicus* appearance in the captioned case. This motion is being filed under Rule 42(3) since, while *Amicus* has been advised by counsel for respondent Ag Pro, Inc. that it has no objections to giving consent to *Amicus* to appear in this case, counsel for petitioner Sakraida has indicated that petitioner will not give his consent.

II.

INTEREST OF AMICUS

This case involves, *inter alia*, an interpretation of Art. 1, Sec. 8, Cl. 8, of the Constitution and 35 U.S.C. § 103 and, more particularly, the application of the statutory unobviousness test to a so-called "combination" patent where all the claimed elements of the combination are admittedly old.[1] This case represents the first opportunity since *Graham v. John Deere Co.*, 383 U.S. 1 (1966)[2] and *Anderson's – Black Rock, Inc. v. Pavement Salvage Co.*, 393 U.S. 57 (1969), for the Court to apply the unobviousness test to a combination patent and to cure the confusion in applying this standard which exists in the lower courts.

Amicus contains about 4200 members, many of whom are patent lawyers who are vitally interested in the proper functioning of the patent system. These patent lawyers represent and serve the interests of clients ranging from individual inventors to the largest corporations, to all of whom the patentability issues under consideration here are of vital importance. The question of the standard of patentability of combination inventions far transcends the narrow interests of the parties to this case and will have a profound effect on decisions such as, for example, whether it is worthwhile to file a patent application on a new development or whether a large research expenditure should be made in view of the type of patent protection available. Accordingly, the views of those who render advice to the people who make these decisions deserve to be heard.

[1] The three issues presented by the petitioner are (1) the unobviousness question, (2) whether the Court of Appeals erred in setting aside the Trial Court's finding of invalidity, and (3) whether the Court of Appeals erred in setting aside the Trial Court's findings that petitioner was entitled to a new trial. If this motion is granted, *Amicus* will address only issue (1).

[2] Decided concurrently with *Calmar, Inc. and Colgate-Palmolive Co. v. Cook Chem. Co.*, 383 U.S. 1 (1966); and *United States v. Adams*, 383 U.S. 39 (1966). *Graham*, *Calmar* and *Adams* will hereinafter collectively be referred to as "*Graham.*"

III.

DISCUSSION

In 1966, this Court handed down its celebrated opinions in *Graham*, which many in the patent bar applauded as a clear and succinct statement of the unobviousness standard of 35 U.S.C. § 103 and how it was to be implemented. *Graham*, it was hoped, would put an end to the confusion which theretofore had existed among the courts as to what was a patentable invention and would thus stabilize this vital area of the law.

Such hopes, however, were stillborn. For since *Graham* was decided, the United States Courts of Appeals have split over *Graham's* criteria for unobviousness in two different and inconsistent ways. The inevitable consequence of this lack of uniformity in decisions

> is that patent owners and alleged infringers spend inordinate amounts of time, effort and money jockeying for a post position in the right court for the right issues. Nowhere is the quest more vigorously pursued than for the right forum to rule on validity. Patentees now scramble to get into the 5th, 6th and 7th Circuits since the courts there are not inhospitable to patents whereas infringers scramble to get anywhere but in these circuits. Such forum shopping not only increases litigation costs inordinately and decreases one's ability to advise clients, it demeans the entire judicial process and the patent system as well.[3]

It is accordingly of great public importance to the continued vitality of the patent system that the proper test for unobviousness be chosen and correctly applied to the resolution of the underlying factual issues. The instant case provides this Court with its first opportunity since *Graham* and *Black Rock* (which itself did more to confuse than to clarify the existing confusion) to apply the unobviousness test and to provide much-needed guidance to the lower federal courts. Indeed, such need was highlighted by the Fifth Circuit

[3] Commission on Revision of the Federal Court Appellate System, Structure and Internal Procedures: Recommendations for Change, at A-178 (June 1975).

in the instant case, when it noted that "Although the Court in *Graham* clearly rejected the Fifth Circuit rationale that an invention is patentable when it produces an 'old result in a cheaper and otherwise more advantageous way,' what precise test, if any, that Court substituted is unclear."

This issue may not adequately be treated by the parties to this case, simply because *their* interests revolve narrowly about the patentability or lack of it of the patented barn cleaning system. While *Amicus* does not question the parties' ability to present their limited concerns adequately to the Court, as often happens in situations such as this, the broad public interest in clarification of the law is overshadowed by the private interests which bring the parties together before the bench.

IV.

CONCLUSION

If the proper test to be applied is clarified by the Court now, patent owners, businessmen and potential infringers can order their business activities to accord with whatever threshold level of patentability this Court enunciates. Whatever the level, the parties will be able to predict with some degree of accuracy what test lower courts will select to determine the validity of patents which come before them.

Amicus feels it is in a position to assist the Court in making its determination. For this and the foregoing reasons, this request for permission to make an *amicus* appearance on the first question presented by the petitioner should be granted.

Respectfully submitted,

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BRIEF AMICUS CURIAE OF THE BAR ASSOCIATION OF THE DISTRICT OF COLUMBIA

I. INTEREST OF AMICUS

The essential interest of *Amicus* in this case is to urge the Court to resolve existing conflicts in the application of the *tests* of patentability by different tribunals so as to foster the development of a uniform body of law. Accordingly, *Amicus* takes no position as

to whether, on the facts of record, the patent in suit should be held valid or invalid. It is only the tests to be applied in validity adjudication, the lines of analysis of the facts of record, and the treatment of various types of evidence with which *Amicus* is concerned.[4]

II. SUMMARY OF ARGUMENT

This Court's celebrated *Graham* opinions interpreted the general condition of patentability as set forth in 35 U.S.C. § 103. The § 103 nonobviousness standard was held to be the operative test of the patentability of new and useful inventions. Guidelines for determination of obviousness or nonobviousness were provided, and the Court expressly sanctioned consideration of so-called "secondary" or subtest evidence as it may bear on nonobviousness in any given case.

Uncertainty and conflict has arisen with respect to the proper application of the § 103 condition, especially as to inventions which are considered to be "combinations" of known elements, and with respect to the relevance of "secondary" considerations. These are conflicts which must be resolved by this Court if there

[4]Petitioner Sakraida presents three (3) questions for consideration by this Court. This *amicus* brief deals only with the tests for determining patentability issues, which are involved in Petitioner's question 1 as set forth in Petitioner's Main Brief at 4. This brief does not specifically deal with the "overclaiming" issue raised as part of question 1 in Petitioner's Main Brief. The Court's attention is, however, directed to this Court's holding in Williams Mfg. Co. v. United Shoe Machinery Corp., 316 U.S. 364 (1942), which discusses this subject at length.

is ever to be a uniform and reasonably predictable law of patentability. This case provides the Court with the opportunity to do so.

A special test of "combination" claim patentability, sometimes applied, is inconsistent with the § 103 nonobviousness standard as construed in *Graham*. It precludes inquiries which could lead to resolution of the obviousness issue. Moreover, it has long been recognized that all inventions can be characterized as combinations of known things; people do not create using the unknown. This further undercuts any rational basis for a special test of "combination" patentability.

Amicus takes no position as to the patentability of the invention of the patent in suit. The Court is simply requested to reaffirm the exclusivity of § 103 nonobviousness as the criterion of patentability; to reject a special test for so-called "combination" patents; and to review the validity of the patent in suit using the *Graham* pattern of analysis leading to a determination of obviousness or nonobviousness.

The so-called "secondary" evidence, such as evidence of long-felt need in the art, failure of others to recognize or provide solutions to long-standing problems and commercial acceptance of an invention, shed light on the circumstances surrounding the making of an invention and provide a basis for sound inferences concerning the level of ordinary skill in the pertinent art at the time the invention was made. Where such evidence exists it is directly relevant to the factual inquiries held in *Graham* to be threshold considerations to a determination of obviousness or nonobviousness. Some courts have held, to the contrary, that such evidence is not relevant to patentability. The Court

should correct this error and insist on the consideration of *all* evidence bearing on the § 103 obviousness issue *before* reaching a decision thereon.

By reaffirming § 103 nonobviousness as the sole test of patentability of new and useful inventions and by acknowledging the relevance of subtest evidence in *all* cases, the Court will take a major step in setting the courts and the Patent Office on the proper course toward development of a uniform and reasonably predictable patent law. This will further a fundamental objective of Congress in enacting the § 103 nonobviousness standard of the 1952 Patent Act.

III. ARGUMENT

A. INTRODUCTION

In *Graham* this Court held the 35 U.S.C. § 103 nonobviousness test of patentability to be in keeping with the Constitutional authorization for Congress to enact patent laws.[5] In addition to discussing the § 103

[5] *See* 383 U.S. at 17. The relationship between the § 103 nonobviousness standard and a Constitutional standard was discussed in Comm'r. Pats. v. Deutsche Gold-und-Silber-Scheideanstalt Vormals Roessler, 397 F.2d 656 (D.C. Cir. 1968), the court noting that in *Graham* this Court implied "that advancement was the equivalent of 'Progress' as used in the constitutional phrase". 397 F.2d at 665. The Commissioner of Patents had apparently urged "advance in the art" as a *separate* additional condition of patentability. The Court of Appeals, speaking through Judge (now Chief Justice) Burger, rejected this argument and held as follows:

> If advance in the useful art is the necessary standard to sustain patentability, the more logical view is that three independent statutory conditions are not separate from advancement but are the very indicia of it, in particular the condition of non-obviousness. *See* Note, 54 Geo.L.J. 1320, 1339 (1966).
>
> Under this analysis we have some difficulty in perceiving how a claimed compound which is new, useful, and unobvious can still *not* constitute an advance in the art. The Commissioner's position is that even if the three conditions are fulfilled, a step *backward* in the art is not patentable. But the relevant art does not go "backward" when the three conditions are fulfilled. The Commissioner's position appears to be a contradiction in terms. [Footnotes omitted.] 397 F.2d at 666.

standard and providing guidelines for its application, the Court directed the Patent Office and the courts to use nonobviousness as the operative test of patentability of new and useful inventions so as to provide a reasonably uniform and predictable body of law.[6] In addition, *Graham* specifically sanctioned consideration of certain evidence, such as long-felt need in the art, failure of others to recognize or provide solutions to long-existing problems, and commercial success – the so-called "secondary considerations"[7] or "subtests" of nonobviousness.[8]

Since *Graham*, there has been divergence, rather than uniformity, in the standards of patentability as applied not only in the different circuits, but by different panels of the same circuit as well.[9] Some tribunals have

[6] Novelty and utility are two of the conditions of patentability. 35 U.S.C. §§ 101 and 102. Compliance with these requirements does not appear to be at issue in this case.

[7] 383 U.S. at 17-18.

[8] *Id.* at 36.

[9] Comprehensive statistical and substantive compilations and analyses lead to the necessary conclusion that the various U.S. Courts of Appeal are using more than one set of legal standards.

applied a special test of patentability to inventions considered to be combinations of known elements,[10] while others have remained true to the *Graham* mandate to evaluate *all* inventions under the § 103 nonobviousness-obviousness standard.[11] Also, some courts have refused to consider the subtests which *Graham* held to be potentially indicative of nonobviousness,[12] while others have followed *Graham* in this respect.[13]

The Court's later opinion in *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969), referred to both the § 103-*Graham* nonobviousness standard and the special test of combination patentability without providing resolution of the inconsistencies between those two tests. Moreover, *Black Rock* denigrated the probative value of the subtest factors in the absence of "invention", while expressing the need for courts and the Patent Office to focus on the § 103-*Graham* test of patentability. The seemingly internally conflicting analysis of *Black Rock* has

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Thus, the Seventh and Fifth Circuits' holding 45.6% and 51.8% of their adjudicated patents to be valid, after *Graham*, according to a 1970 study, was strikingly different from the Eighth and Ninth Circuits' holdings of 0.0% and 16.3%, respectively, during the same time period. See Kayton, *The Crisis of Law in Patents*, P. I, 5 (Patent Resources Group, Wash. D.C. 1970).

[10] *See, e.g.*, Jeddeloh Bros. Tweed Mills, Inc. v. Coe Mfg. Co., 375 F.2d 85, 88 (9th Cir. 1967), *cert. denied*, 389 U.S. 823 (1967).

[11] *See, e.g.*, Reeves Instrument Corp. v. Beckman Instruments, Inc., 444 F.2d 263 (9th Cir. 1971), *cert. denied*, 404 U.S. 951 (1971).

[12] *See, e.g.*, Vanity Fair Mills, Inc. v. Olga Co., 510 F.2d 336, 340 (2d Cir. 1975).

[13] *See, e.g.*, ADM Corp. v. Speedmaster Packaging Corp., 384 F. Supp. 1325, 1345 (D.N.J. 1974).

unavoidably introduced uncertainty as to the meaning of the *Graham* interpretation of the § 103 nonobviousness standard. This uncertainty is especially acute in the two important areas of so-called combinations of old or known elements and the evidentiary status of the so-called "secondary" considerations or "subtests" of nonobviousness.

The state of patent law in this area today is such that the Patent Office and the courts can and do draw from either of two dichotomous lines of thought to support, from case to case, inconsistent tests for patentability. Obviously, both cannot be proper under the *Graham* analysis. In contrast, this Court has held the legislative intent in enacting § 103 as part of the 1952 Patent Act was to obtain judicial and administrative adherence to the standard of nonobviousness, and attain a single, uniform body of patent law.[14] The realization of that objective is of vital public importance.

With this background in mind, *Amicus* seeks to persuade the Court to reaffirm the § 103 obviousness-nonobviousness standard as explicated in *Graham* as the *exclusive* test to be applied to the patentability of new and useful inventions. In so doing, the Court should require the consideration of *all evidence* relevant to the obviousness-nonobviousness question in each case in which the question is raised without harking back to pre-1952 Patent Act subjectivity.

Petitioner Sakraida presents three (3) questions for consideration by this Court. This *amicus* brief deals only with the tests for determining patentability issues, which are involved in Petitioner's question 1 as set forth in Petitioner's Main Brief at 4.

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[14] Graham v. John Deere Co., 383 U.S. at 18.

B. THE SECTION 103 NONOBVIOUSNESS TEST AS INTERPRETED IN *GRAHAM* IS THE OPERATIVE TEST OF THE PATENTABILITY OF NEW AND USEFUL INVENTIONS.

Since enactment of our earliest patent statutes, Congress has required that, to be patentable, a discovery must be new and useful. These two requirements are inherently comprehensible and, with a modest degree of legislative and judicial refinement over the years, have spawned comparatively little controversy.

As revealed in *Graham*, greater difficulty has been experienced in defining and applying a standard for determination of whether or not particular new and useful discoveries differed sufficiently from what was known to warrant the grant of a patent.[15] Probably the earliest judicial expression of a third requirement of patentability appears in *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248, 267 (1850):

> [U]nless more ingenuity and skill . . . were required . . . than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the

[15] *Id.* at 5-19. Because the early patent board could not handle the task of delineating the patentable from the unpatentable, it was, as Thomas Jefferson, a board member, wrote, "turned over to the judiciary to be matured into a system, under which every one might know when his actions were safe and lawful." Letter from Jefferson to Isaac McPherson, August 1813, in VI *Writings of Thomas Jefferson* at 182 (Washington ed.).

> work of the skillful mechanic, not that of the inventor.

Approximately a century later, Congress, for the first time, incorporated this additional condition of patentability in the patent statutes. Section 103[16] of the Patent Act of 1952 provides in pertinent part that:

> A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

This court has noted that the standard of nonobviousness to a person having ordinary skill in the art is "strongly reminiscent" of the *Hotchkiss* requirement for more ingenuity and skill than possessed by an ordinary mechanic acquainted with the business.[17] However, referring to *Hotchkiss*, the Court in *Graham* stated that:

> The language in the case, and in those which followed, gave birth to "invention" as a word of legal art signifying patentable inventions. Yet, as this Court has observed, "[t]he truth is the word ['invention'] cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of inventive faculty or not." McClain v. Ortmayer, 141 US 419, 427, 35 L ed 800, 803, 12 SCt 76 (1891); A. & P. Tea Co. v Supermarket Corp., supra, 340 US, at 151, 95 L ed at 166. Its use as a label brought about a large variety of opinions as to its meaning both in the Patent Office, in the courts, and at the bar.[18]

[16] 35 U.S.C. § 103.

[17] Graham v. John Deere Co., 383 U.S. at 14, 17.

[18] *Id.* at 11-12.

As a test or standard of patentability, the requirement for "invention" lacked inherent direction as to what inquiries could lead to determinination of compliance with it. The test of "invention" suffered, therefore, from an inability to be applied with any reasonable degree of objectivity or predictability.[19]

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[19]*See generally*, Note, *After Black Rock: New Tests of Patentability–The Old Tests of Invention*, 39 Geo.Wash.L.Rev. 123, 124-144 (1970), which was co-authored by one of the drafters of this *amicus* brief. Judge Giles S. Rich of the United States Court of Customs and Patent Appeals has written several commentaries on the evolution and development of the general requirement for patentability. *See* Rich, *The Vague Concept of "Invention" as Replaced by §103 of the 1952 Patent Act*, 8 Idea 136 (1946); Rich, *Congressional Intent–Or, Who Wrote the Patent Act of 1952*, Patent Procurement and Exploitation 61, 70 (B.N.A. 1963); Rich, *Principles of Patentability*, 28 Geo. Wash. L. Rev. 393 (1960). Judge Rich has been acknowledged to have been, as a private practitioner at the time, one of the principle draftsmen of the 1952 Patent Act in general and § 103 in particular. *See* the comments of Mr. Crumpacker, a former Congressman and member of the House Subcommittee and Committee out of which the patent bill was reported, in Crumpacker, *The Patent Act of 1952–A Congressional Perspective*, Summary of Proceedings, A.B.A.–Section on Patents, Trademarks and Copyright Law 141, 143 (1962).

Judge Rich again commented on the § 103 standard of patentability in *Laying the Ghost of the "Invention" Requirement*, 1 A.P.L.A.J. 24 (1972), an exposition which one federal court recently lauded as "a most persuasive substantive analysis of the subject." Opinion of Chief Judge Pettine in Rosen v. Lawson-Hemphill, Inc., ____ F.Supp. ____, 187 U.S.P.Q. 158, 169 n.14 (D.R.I. 1975). *Amicus* respectfully calls this Court's attention to that article by Judge Rich which, because of its lucid and authoritative treatment of the issues raised in the present case, is reproduced in full as the sole Appendix hereto for the convenience of the Court.

There is no reference to a requirement of "invention" in the 1952 Patent Act. Associate Judge Rich of the Court of Customs and Patent Appeals, a co-author of the Act, has said that "the drafters did this deliberately in an effort to free the law and lawyers from bondage to that old and meaningless term. . . ."[20] The term "invention" is used in the 1952 Patent Act only to denote the thing discovered, devised or created, and not to measure the *patentability* of a new product, apparatus or process.[21] Thus, under the Act, there are patentable as well as unpatentable "inventions." Once this is understood, "invention" cannot be a test for "patentability." In this connection, it was specifically held in *Graham* that:

> The major distinction [between the § 103 and *Hotchkiss* formulations] is that Congress has emphasized "nonobviousness" as the operative test of the section, rather than the less definite "invention" language of Hotchkiss that Congress thought had led to "a large variety" of expressions in decisions and writings. In the title itself the Congress used the phrase "Conditions for patentability; *non-obvious subject matter*" . . . [emphasis the Court's], thus focusing upon "non-obviousness" rather than "invention".[22]

Against this historical background, including the recognition of the lack of stability born of the intrinsically subjective and indefinite "invention" requirement, the Court, in *Graham*, expressed confidence that:

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[20]Rich, *Congressional Intent*, *supra*, Patent Procurement and Exploitation at 70.

[21]*See generally*, Janicke, *The Varied Meanings of "Invention" in Patent Practice: Different Meanings in Different Situations*, Pat. L. Persp. (1971).

[22]383 U.S. at 14.

> [T]he § 103 additional condition, when followed realistically, will permit a more practical test of patentability.[23]

Moreover, it was felt that:

> [S]trict observance of the requirements laid down here will result in that uniformity and definiteness which Congress called for in the 1952 Act.[24]

Re-dedication to that objective will follow if the Court takes the opportunity presented by this case to emphasize that under § 103 nonobviousness is the *sole* operative test of patentability of new and useful inventions and that a decision on nonobviousness must be made *only* after consideration of *all* relevant evidence.

C. THE *GRAHAM* ANALYTICAL APPROACH TO SECTION 103 NONOBVIOUSNESS SHOULD BE EXCLUSIVELY FOLLOWED IN EVERY CASE IN WHICH PATENTABILITY UNDER SECTION 103 IS IN ISSUE.

Consistent with the Court's appraisal of the salutary potential of the § 103 nonobviousness standard, the *Graham* opinion set forth guidelines to facilitate proper and reasonably predictable analysis for determination of compliance or non-compliance with that standard. The Court held as follows:

> [T]he Section 103 condition . . . lends itself to several basic factual inquiries. Under Section 103,

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[23] *Id.* at 17.

[24] *Id.* at 18.

> the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.[25]

To help adjudicating tribunals bridge the gap between the factual analysis and the ultimate determination of obviousness or nonobviousness, the Court discussed the propriety of giving consideration to certain types of evidence, holding that:

> Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. See Note, Subtests of "Nonobviousness," 112 U. Pa. L. Rev. 1169 (1964).[26]

Commenting on such factors in the *Calmar* portion of the opinion, the Court said:

> These legal inferences or subtests do focus attention on economic and motivational rather than technical issues and are, therefore, *more susceptible to judicial treatment than are the highly technical facts* often present in patent litigation. See Learned Hand in Reiner v. I. Leon Co., 285 F.2d 501, 504, 128 USPQ 25, 27-28, cert. den. 366 U.S. 929, 129 USPQ 502 (1960). See also Comment, Subtests of "Nonobviousness." 112 Pa. L. Rev. 1169 (June 1964). Such inquiries may lend a helping hand to the judiciary which, as Mr. Justice Frankfurter observed, is most ill-fitted

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[25] *Id.* at 17.

[26] *Id.* at 17-18.

> to discharge the technological duties cast upon it by patent legislation. Marconi Wireless Co. v. United States, 320 U.S. 1, 60, 57 USPQ 471, 496 (1943). They may also serve to "guard against slipping into hindsight," Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co., 332 F.2d 406, 412, 141 USPQ 549, 555 (1964), cert. denied 379 U.S. 888, 143 USPQ 465, and to resist the temptation to read into the prior art the teachings of the invention in issue. [Emphasis added.][27-29]

The Court actually applied the nonobviousness test in *Graham*, *Calmar* and *Adams*. The patents involved in *Graham* and *Calmar* were found to differ from the art only to such a degree that, considering all the evidence, *the subject matter as a whole* was deemed to have been obvious *at the time the respective inventions were made*. In *Adams*, the Court concluded that even though the individual elements of the claimed battery were previously known in the art, and though the invention seemed simple, consideration of *all* the evidence supported a holding of nonobviousness.

It will be recalled that Adams' invention was a constant-current, nonrechargeable battery which used water as an electrolyte. The structure claimed in the Adams patent was quite similar physically and chemically to the prior art, although it was novel under 35 U.S.C. § 102. The Adams battery used electrodes of cuprous chloride and magnesium. While electrodes of these materials had not been used in the same battery, zinc and silver chloride electrodes had been, and the prior art suggested the equivalency of cuprous chloride and silver chloride electrodes and magnesium and zinc electrodes. Had this Court restricted its consideration to

[27-29] *Id.* at 36.

the small differences which distinguished the Adams battery from prior art batteries, the inventor would have undoubtedly been out of luck. Instead, the differences were examined in the context of the subject matter as a whole, the level of ordinary skill in the pertinent art, the unexpected properties of the combination and the dramatic secondary factors of commercial success, long-felt need and other forms of objective evidence.

In providing direction by delineating the basic factual inquiries, acknowledging the relevance of various types of evidence, and illustrating the application of the *Graham* test in the varying factual settings of *Graham*, *Calmar* and *Adams*, the Court placed much flesh on the skeletal standard of § 103. *Graham* therefore provides a solid foundation on which to build a unitary, rational body of patent law. While the promise has not yet been fulfilled, this Court has the opportunity to reaffirm § 103 and *Graham* as setting forth the sole test of the third requirement of patentability, and thereby to reestablish a course which will lead to attainment of the "uniformity and definiteness which Congress called for in the 1952 Act."[30]

D. SINCE *GRAHAM*, THERE HAS BEEN CONFLICT AS TO THE PROPER TEST OF PATENTABILITY.

After *Graham*, a dichotomy developed as to how the nonobviousness criteria enunciated in *Graham* ought to be applied and what their practical purpose really is. This occurred despite the Court's admonition that:

[30] Graham v. John Deere Co., 383 U.S. at 18.

> [T]he inquiry which the Patent Office and the courts must make as to patentability must be beamed with greater intensity on the requirements of Section 103.[31]

In some instances, courts have correctly utilized the *Graham* analysis. However, other courts have harked back to the test of "invention", employing some of the arbitrary rules which evolved during the era of the "invention" requirement and which find no support, as universal propositions, under the § 103 nonobviousness standard. Still others have discussed both the "invention" and nonobviousness standards, leaving considerable doubt as to what the result would have been had the focus been exclusively on nonobviousness according to *Graham*.

Divergent expressions of the test of patentability have been nowhere more evident than in most important areas which the Court may treat in the present case. These are (1) the assessment of the patentability of a claim to a new combination of elements each of which is considered to be "old" in the art, and (2) whether factors such as long-felt need in the art, failure of others to recognize or provide solutions to long-existing problems in the art and commercial success are to be accorded weight. The existence of a substantial dichotomy in the courts on these two aspects of patentability determination is a major obstacle to the realization of the objective of a uniform and predictable patent law.

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[31] *Id.* at 19.

1. The Special Test of "Combination" Claim Patentability

Prior to the 1952 Act, the Court, in *Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950), held that:

> The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable.

In *A. & P.*, the Court reaffirmed a rule earlier expressed in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 549 (1938), to the effect that:

> The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than theretofore performed or produced by them is not patentable invention.

As explained in more detail in Section E, *infra*, the notion that *A. & P.* and *Lincoln Engineering* prescribed some other and special test for the evaluation of "combination" claims is inconsistent with the § 103 nonobviousness standard. Such a special test would preclude those inquiries delineated in *Graham* as germane to a determination of obviousness or nonobviousness. Hence, where some magic in a supposed *A. & P.-Lincoln Engineering* combination rule has been found to coexist with the § 103 standard, confusion as to the proper approach to patentability has inevitably resulted.

Superficial analysis has found a special test to have been stated by the Court in *A. & P.* in the admonition that courts:

> [S]crutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements.[32-33]

The broader approach announced and exemplified in *Graham* evokes no such foreordained likelihood of obviousness.

While the court below, in the present case, tried to accommodate both the special combination test and the nonobviousness standard, it is apparent that reconciliation is nothing more than a useless journey through a semantic labyrinth.

2. To Consider or not to Consider Evidence Which *Graham* Recognized to be Potentially Indicative of Obviousness.

In *A. & P.*[34] and, unfortunately, in *Black Rock*,[35] the Court stated that such factors as fulfillment of a long-felt want and commercial success "without invention will not make patentability". Such a proposition is incompatible with *Graham* in at least two major respects. First, as aforenoted, the Court in *Graham* explicitly directed attention away from the old "invention" requirement. Secondly, *Graham* squarely held that "secondary" evidentiary factors may be indicative of nonobviousness, *i.e.*, patentability, and in *Adams*, the Court actually found them to be both relevant and persuasive.

There can be no co-existence of the diametrically opposed principles that such ancillary evidence is on the one hand, relevant, and on the other hand, *cannot* be

[32-33] 340 U.S. at 152.

[34] 340 U.S. at 153.

[35] 396 U.S. at 61.

relevant. Consistent with the need to focus on the §103 test, the Court should now direct the Patent Office and courts to consider *all* evidence of nonobviousness, according such *weight* to any individual item as is appropriate under the circumstances of the case. It should be apparent that the availability of these mutually antagonistic principles can only lead to instability and uncertainty in the law.

E. SUBJECTING COMBINATION CLAIMS TO A SEPARATE TEST OF PATENTABILITY IS INCONSISTENT WITH THE *GRAHAM* MANDATE TO FOCUS ON THE §103 STANDARD, AND SUCH AN APPROACH SHOULD BE REPUDIATED.

As noted above, patent claims considered to be drawn to a combination of known elements have, under a rule extrapolated from *Lincoln-Engineering*, *A. & P.* and *Black Rock*, been required by some courts to meet a special test of patentability. Under this rule, the elements must be shown to function differently in combination than they do outside of the combination; they must, in the aggregate, produce a new or different function; and the combination must be determined to have an effect greater than the sum of the effects of its parts, *i.e.*, a "synergistic" result must be realized. Superimposing such special limitations on the *Graham*-§103 nonobviousness standard leads to discord rather than harmony; it prevents development of a consistent body of law under §103. No special test for any

separate class of invention finds rational support in the context of the §103 standard of patentability.[35a]

1. Application of the Special Test for Combinations Results in a Determination of Patentability Which Does Not Involve an Evaluation of Nonobviousness or Obviousness.

A reasoned comparison of the § 103 and combination standards starts with the assumption that the evidence in any given case reveals, *inter alia*, that the subject matter of the patent claim comprises a combination of several elements, each of which was known in some context prior to the invention patented. From that finding, the nature of further inquiry follows different courses depending upon whether the *Graham* and § 103 standard or the *A. & P. - Black-Rock* combination test is to be followed.

Under *Graham* and § 103, the overall scope and content of the prior art are evaluated. The differences between the claimed subject matter and the prior art are identified. The level of skill in the art prevailing at the time the claimed invention was made is evaluated.

In other words, under § 103, a comprehensive study is made of the relationship between the claimed invention and the state of the art as it existed just prior to the time of the invention to facilitate a conclusion as to whether or not a hypothetical person having

[35a] Most importantly, Congress has expressly mandated nonobviousness, not synergism, as the sole test for patentability of novel and useful inventions. While synergism may be evidence of nonobviousness, the latter may exist on a given set of facts without the former. Therefore, any requirement for synergism as a sine qua non of valid combination claims is pointedly inconsistent with the will of Congress.

ordinary skill in the art, *but not having the knowledge of the invention as disclosed in the patent*, would have found it obvious to make the claimed combination. The reconstruction of the mental processes of the person of ordinary skill at a given time is a difficult task. The *Graham* analysis, however, defines factual inquiries which maximize the objectivity of the adjudicatory process.

Starting with the same assumption, but applying the special combination test, a tribunal charged with determining the patentability of a combination has no reason to follow the *Graham* inquiries. The focus immediately shifts to the performance of the elements in combination vis-a-vis their functioning as individual elements apart from the combination. Since it is unnecessary under this approach to determine whether it would have been obvious to *combine* the elements to form the claimed subject matter as a whole, the evaluation of the mental state of the person of ordinary skill—a process mandated by *Graham* and required by § 103—is improperly ignored

The special test for combinations clearly, therefore, engenders a pattern of analysis different from that dictated by § 103 and *Graham*. Even worse, the ultimate legal conclusion required by the statute, i.e., the determination of nonobviousness or obviousness, cannot be drawn after subjecting a claimed invention to the combination test. Simply put, where the prior art reveals each of the elements of a claimed combination, the obviousness or nonobviousness of the invention, *i.e. the combination, should* turn on the obviousness or nonobviousness of *making the combination*, an issue precluded by the special combination test, which looks

solely to the operation of the elements *after* they are combined.[36]

2. The Special Combination Test Has No Rational Supporting Premise in the Context of the §103 Standard.

Since the special combination test required by some courts does not allow for a proper determination of obviousness or nonobviousness, it does not comport with the *Graham* mandate to apply §103. This Court should acknowledge that inconsistency and the resultant conflicts which necessarily arise in patentability adjudications. Moreover, in reviewing the special combination test, considerations in addition to its irrelevance to the §103 standard should be taken into account.

One necessary premise of a special test for combinations is that inventions exist which are *not* combinations.

Judge Learned Hand addressed this point on several occasions. In *Reiner v. I. Leon Co.*, 285 F.2d 501, 503 (2d Cir. 1960), *cert. denied*, 366 U.S. 929 (1961), he observed that:

> It is idle to say that combinations of old elements cannot be inventions; substantially every invention is for such a 'combination'; that is to say, it consists of former elements in a new assemblage.

His view had not changed over the fourteen year period between his opinion in *Reiner* and that delivered in *Safety Car Heating and Lighting Co. v. General Electric Co.*, 155 F.2d 937, 939 (2d Cir. 1946), wherein he stated:

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[36]*See* Note, *After Black Rock*, note 18 *supra*, 39 Geo. Wash. L. Rev. at 134.

> Substantially all inventions are for the combination of old elements; what counts is the selection, out of all their possible permutations, of that new combination which will be serviceable.

That is neither exaggeration nor sophistry. It is true. Scientists and engineers, no matter how brilliant, do not create without using elements, components, materials or techniques that are known.[37]

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[37]Professor C.E. Ayres, who has devoted a lifetime to the study of inventions and discoveries and their economic consequences, made the observation in somewhat greater detail and from another point of view:

> [T]here is no difference between 'mechanical' invention and 'scientific' discovery. Scientific discoveries also result from the combination of previously existing devices and materials, laboratory instruments and techniques. It was by combining a magnet with a Crookes tube, for example, that J.J. Thomason discovered that the steam of incandescence in the tube was in fact a steam of physical particles and was even able to calculate the mass of the electrons. It was by combining a prism with a telescope that astronomers were able to identify elements (such as helium) in the sun. Even in the fine Arts 'creation' comes about in the same way. Leonardo's great achievement illustrated by the famous Mona Lisa . . . was that he applied techniques which the monks had devised for the protrayal of angels to the portraiture of living subjects. Cezanne characterized his achievement as resulting from the application of Pissarro's studio technique to painting from nature, in every innovation analysis reveals the combination of previously existing devices. That is what the achievement is which in different fields we call invention or discovery or creation.

Ayres, C.E., *The Theory of Economic Progress* 115 (University of North Carolina Press, Chapel Hill (1944)). Ayres had earlier made the same point in *The Problem of Economic Order* 13, (Farrar & Rinehart, Inc. New York (1938)), as follows:

> Whatever the ingenuity of the individual inventor, an invention always results from the combination of pre-existing mechanical contrivances. No chemist, however

In the setting of an adjudication of patentability, especially civil litigation involving patent validity, the claimed subject matter can always be retrospectively examined in light of its component elements and the court or other tribunal shown the existence of those elements in the prior art. There is no imaginable situation in which the components of a combination have not separately and previously existed *in some context.* Even Dr. Seaborg's invention of the trans-uranium elements,[38] curium and americum, involved combinations of old or known elements – protons, electrons and the like. The adjudicating tribunal can always be apprised of these as part of the state of knowledge existing prior to the invention. But the inquiries *should* ultimately lead to decision as to whether given knowledge of the elements in their known contexts, in light of the prevalent skill in the art, combining those particular known elements in the manner of the invention, out of all other possible combinations which might be made, would have been an obvious thing to do. The inquiries *should not* center *exclusively* on the performance of elements *after* combination and without regard to the obviousness or nonobviousness of *making the combination.*

In *Reeves Instrument Corp. v. Beckman Instruments, Inc.*, 444 F.2d 263 (9th Cir. 1971), *cert. denied*, 404 U.S. 951 (1971), the McCoy patent, relating to computer technology, was contended by defendant to be a combination of old elements which is unpatentable under the special combination test. The court stated:

brilliant, could bring about a given chemical reaction if the substances of which it is the reaction did not exist, and no mechanical genius could apply the vacuum tube to wireless telephony if neither telephony nor wireless telegraphy nor vacuum tubes had been developed.

[38] *See In re* Seaborg, 328 F.2d 993, 996 (CCPA 1964).

Beckman's initial contention here is that the McCoy patent is somehow invalid on its face, without regard to the prior art, in view of Great Atlantic & Pacific Tea Co. v. Supermarket Equip. Corp., 340 U.S. 147, 87 USPQ 303 (1950). Specifically, we are warned to scrutinize carefully those patents which include combinations of elements which are individually old in light of the alleged improbability of finding invention in such a combination. The argument is that the McCoy patent fails to satisfy the constitutional standard of patentability enunciated in A&P because the claimed invention consists of old elements (amplifiers, potentiometers, switches, etc.) which operate within the claimed combination in the same fashion as they have always operated in the prior art.

This argument fails on two grounds. First, it misconstrues the import of the A&P decision. Second, it suggests an analytical approach to patentability which is directly contrary to the statutory language of 35 U.S.C. § 103 which provides that the inquiry into patentability must be drawn toward the "subject matter as a whole" and not to the elements of a claimed combination and their individual novelty.

The claims in issue here, are, in statutory language, "machine" claims. They define a new "machine" which is composed of certain defined elements in combination. Carried to its logical conclusion, the argument here would result in a rule to the effect that A&P precludes the patenting of virtually every new mechanical or electrical device since the vast majority, if not all, involve the construction of some new device (or machine or combination) from old elements. [Footnote omitted].[39]

[39] 444 F.2d at 270.

In a footnote, the court added:

> Carried even further, there is doubt that anything would be patentable. Not only are all mechanical and electrical devices constructed of old elements but all chemical products are the result of combining known chemical elements. To continue to reduce patentability with a view toward uses of old elements would ultimately lead to the conclusion that those "inventions" which survive are unpatentable because they amount to no more than a discovery of something which already existed in nature. See Vitamin Technologists, Inc. v. Wisconsin Alumni Research Foundation, 146 F.2d 941, 63 USPQ 262 (9th Cir. 1944).[40]

The *Reeves* court construed *A. & P.* and *Black-Rock* as cases in which a holding of obviousness followed from the facts there present. However, other courts have found the special combination test to define the standard with which there must be compliance.

In addition to the unrealistic assumption that there may be combinations of other than old or known elements, it is evident that the special combination test is unworkable as compared to §103 nonobviousness. The requirement that the elements function differently in combination than they do individually is not only of little or no[40a] significance to a meaningful determi-

[40] *Id.* at 270 n. 4.

[40a] *Amicus* believes that, in fact, there is no such thing as an element functioning differently in combination than it did outside of the combination, e.g., a screw or an inclined plane will always function as a screw and inclined plane, respectively, alone or in concert with other elements. Assuming arguendo that there exists an exception to this belief, the new function should, nevertheless, *not* be a sine qua non to a finding of patentability but merely be taken as evidence to be considered along with the other evidence available in the obviousness/non-obviousness inquiry.

nation of obviousness or nonobviousness, but precludes consideration of evidence which *is* material to such a determination.

The realization of a new or different *function in* combination is different from the production of a new or different *result from* the combination. The latter, of course, is a significant factor in determining nonobviousness, as the Court effectively demonstrated in *Adams.* It was the totally new and different *result* produced by the Adams battery that led the Court to hold it patentably nonobvious *despite the fact that each element of the battery (every one of which was old) functioned in exactly the same way as it did in the prior art.* Indeed, the government's attack on nonobviousness attempted to exclude the new and different nature of the result and focused exclusively on the fact that each element was known and each functioned as taught by the prior art. The combination, the invention as a whole, was responsible for the startling result.

That the supposed special combination test would be a severe test is apparent from the *A.&P.* admonition that:

> Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements.

Amicus agrees that under such a special combination test, with its narrow criteria, so-called "combination" patents will not likely be found to be valid. The *A. & P.* admonition itself, regrettably resuscitated in *Black Rock,* must inevitably bias adjudicating tribunals against a finding of validity or patentability.

However, *Amicus* would strenuously disagree that under the § 103-*Graham* analysis, a finding of *nonob-*

viousness in so-called "combination" inventions is either more difficult or improbable. It is essential to recognize that all inventions can be dissected and characterized as composed of previously known elements; that the state of knowledge and levels of skill vary so that small modifications made in readily comprehendable technologies may, under a given set of circumstances, be totally unobvious, while seemingly large changes in a very sophisticated art may be quite obvious; and that the § 103 standard as elucidated in *Graham* provides a rational means of evaluating *all* inventions for patentability without regard to rhetorical characterization or unguided subjective conclusion.

For all of these reasons, the Court is urged to repudiate a special test for so-called combinations of old elements and to insist on the application of the single test announced in *Graham* to *all* inventions. Such direction by the Court will be a major step toward achieving the long-needed uniformity in patentability standards.

F. CONSIDERATION OF *ALL* EVIDENCE ENSURES A REASONED DETERMINATION OF OBVIOUSNESS OR NONOBVIOUSNESS.

The narrow focus of the special combination test inherently excludes consideration of evidence which might shed light on the nonobviousness or obviousness of a claimed invention – combination of known elements or otherwise, if such were possible. Moreover, as noted above, special rules developed in connection with the obsolete "invention" requirement expressly foreclose consideration of certain evidence.

Where the "invention" test was so totally subjective in nature, the evolution of specific rules was probably necessary to afford some tangible means of determining its presence or absence. In contrast, nonobviousness to one having ordinary skill in the art at the time the invention was made has intrinsic tangibility, and the probative value of different types of evidence under the individual circumstances of each case can be rationally assessed. There is, therefore, no need for *exclusionary* rules.

To the contrary, evidence of the state of a particular technology prior to the appearance of the invention and the reaction of the industry to the invention after its appearance may be of substantial assistance to the court in attempting to assess whether the skill of the art was such that the invention would have been obvious or nonobvious. As this Court has noted, such evidence:

> [M]ay also serve to "guard against slipping into use of hindsight," Monroe Auto Equipment Co. v. Heckethorn Mfg. & Sup. Co., 332 F.2d 406, 412 (1964), and to resist the temptation to read into the prior art the teachings of the invention in issue.[41]

As a result of his experiences, Judge Learned Hand also found such evidence to be of the greatest relevance in patentability determinations. His views were cogently summed up in *Safety Car Heating and Lighting Co. v. General Electric Co.*, 155 F.2d 937, 939 (2d Cir. 1946), as follows:

> In appraising an inventor's contribution to the art, as we have often said, the most reliable test is to look at the situation before and after it appears. Substantially all inventions are for the combination of old elements; what counts is the selection, out

[41] Graham v. John Deere Co., 383 U.S. at 36.

of all their possible permutations, of that new combination which will be serviceable. No objective standard is practicable: . . . as, for example, whether each of the elements operates in a different way from what it did in other combinations. That is almost never true of a machine; each member ordinarily performs the same mechanical function which it does in any other machine; it is their cooperation that produces the result, and the value of that cooperation depends upon the sagacity which divined the end and fabricated the means. Courts, made up of laymen as they must be are likely either to underrate, or to overrate, the difficulties in making new and profitable discoveries in fields with which they cannot be familiar; and, so far as it is available, they had best appraise the originality involved by the circumstances which preceded, attended and succeeded the appearance of the invention. Among these will figure the length of time the art, though needing the invention, went without it: the number of those who sought to meet the need, and the period over which their efforts were spread: how many, if any, came upon it at about the same time, whether before or after: and—perhaps most important of all—the extent to which it superseded what had gone before. We have repeatedly declared that in our judgment this approach is more reliable than a priori conclusions drawn from vaporous, and almost inevitably self-dependent, general propositions.

In many ways the problem is similar to situations when so-called "structurally obvious" chemical compounds *i.e.*, different but very similar structurally, are sought to be patented. It was asserted before the Court of Appeals for the District of Columbia in *Commr. Patents v. Deutsche Gold-und-Silver-Scheideanstalt Vormals Roessler*, 307 F.2d 656, (1968), that *Graham*

demanded that once an invention was determined to be "structurally obvious" that was the end of the matter. The court, in a clearly reasoned opinion, rejected this argument. The unexpected properties of the new compound supported the conclusion that those skilled in the art would not have found the new compound obvious.

Closeness structurally to the prior art or simplicity in concept can never tell the whole story on obviousness. For example, in the *Eibel Process* case,[42] the improvement in the Fourdrinier machine was really made when the reason for the limitation on the speed of the existing machine was understood. Raising one end of the machine some fifteen inches with respect to the other end was a small change, but it permitted a major increase in speed to be attained. Interestingly, in *Eibel Process*, the Court noted that, in the opinion of the lower courts, "The prior art and the obvious application of the principle that water will run down hill . . ."[43] precluded patentability. But like the Fifth Circuit in the present case, the Court recognized that Eibel was not trying to patent gravity. Moreover, that new discoveries follow the immutable natural laws of physics is not surprising. Balancing the totality of the evidence in *Eibel Process* led the Court to a more reliable conclusion of patentability than a bare bones view of the machine itself.

It would not be a new direction in the law for this Court to declare evidence of the foregoing nature to be of relevance. As pointed out above, that was the

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[42]Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U.S. 45 (1923).

[43]*Id.* at 52.

holding in *Graham*.[44] It is unfortunate that some courts have interpreted the Court's use, in *Graham*, of the term "secondary" in connection with these evidentiary matters to mean "of lesser importance." It is clear from the reference in the *Calmar* portion of the opinion to "subtests" of patentability that this is not what the Court meant.

The secondary considerations are secondary in time only.[45] As evidence they are necessarily not only primary, but may be the *only* evidence that can be derived on the issue of what is obvious to a person of ordinary skill in the art.[46] As recently stated in *Timely Products Corp. v. Arron*, _____ F.2d _____, 187 U.S.P.Q. 257, 261 (2d Cir. 1975):

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[44]Graham v. John Deere Co., 383 U.S. at 17-18, 36. *See* text accompanying notes 25-26, *supra*. *See also In re* Fielder, 471 F.2d 640 (C.C.P.A. 1973), and Rich, *Laying the Ghost of the "Invention" Requirement*, note 18, *supra*, 1 A.P.L.A.J. at 38-39, Appendix hereto at 13A-14A.

[45]Note, *After Black Rock*, note 18, *supra*, 39 Geo. Wash. L. Rev. at 142 n. 127, wherein the nature of the secondary considerations is described as follows:

> These evidentiary considerations are "secondary" in the sense that they occupy a different level in the hierarchy of legal and factual conclusions. Obviousness is the ultimate issue; the claimed invention, prior art and level of skill in the pertinent art, and difference between the prior art and claimed invention as compared to the level of skill in the art are all sub-issues preliminary to the determination of obviousness. To resolve the crucial sub-issues a court entertains factual evidence such as the claims, specification and file history of the patent, prior patents, publications and testimony of those skilled in the art *and* any other facts such as commercial success and long-felt need.

[46]See *Rich, Laying the Ghost of the "Invention" Requirement, note 19, supra*, 1 A.P.L.A.J. at 38-39, Appendix hereto at 13A-14A.

> In referring to such factors as 'secondary considerations' the Court surely did not intend to depreciate their importance, but only to indicate that they are to be considered *after* a preliminary determination of the precise subject matter at issue has been completed.[47]

Reaffirmation of the consideration of this type of evidence as it bears on the *Graham* factual inquiries and the determination of obviousness or nonobviousness in any given case is essential to rational development and application of the § 103 standard. *Amicus* offers no opinion of how those factors, to the extent they are raised, may weigh in the present case. However, the Court is urged to confirm that their significance must be considered before reaching a decision on obviousness or nonobviousness. The notion that any evidence can be ignored, as a general proposition, or that it suddenly becomes relevant only if patentability is otherwise in doubt, should be rejected as inappropriate to meaningful, rational and consistent application of the § 103 test.

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[47]The Second Circuit in *Timely Products* also noted:

> We can conceive of no better way to determine whether an invention would have been obvious to persons of ordinary skill in the art at the time, than to see what such persons actually did or failed to do when they were confronted with the problem in the course of their work. If the evidence shows that a number of skilled technicians actually attempted, over a substantial period, to solve the specific problem which the invention overcame and failed to do so, notwithstanding the availability of all the necessary materials, it is difficult to see how a court could conclude that the invention was "obvious" to such persons at the time. _____ F.2d at _____, 187 USPQ at 261.

By subjecting the patented invention here in suit to the *Graham* analysis and by considering all the evidence *before* reaching a subjective conclusion which might not otherwise fairly reflect the obviousness or nonobviousness of this invention to those of ordinary skill in the art at the time of the invention, this Court will take a major and needed step in the evolution, finally, of a uniform, reasonably predictable and, therefore, reliable patent law.

IV. CONCLUSION

Amicus urges no specific holding of validity or of invalidity of the patent in suit. It is the standard and approach to determination of patentability with which *Amicus* is concerned.

Amicus has pointed out that the courts and the Patent Office have available to them seriously divergent lines of analysis and inquiry from which to draw in attempting to assess patentability. Specifically, there is, on the one hand, the § 103 nonobviousness standard as embellished upon the well-reasoned *Graham* opinions and, on the other, the inconsistent combination of old elements test, which evolved during the pre-1952 "invention" requirement era. There are also the mutually exclusive lines of reasoning concerning the probative value of non-technical evidence which *Graham* recognizes to be indicative of nonobviousness, while other cases preclude consideration "in the absence of invention."

If the tests of patentability urged by Petitioner and *Amicus* Texas Farmers Union are adopted, the state of

the patent law will continue to be one of conflict and uncertainty, rather than rational and consistent analysis of patentability under the § 103 nonobviousness standard. The possibility will then clearly exist for adjudicating tribunals to reach totally subjective decisions respecting validity which can then be supported, after the fact, by one or the other of the inconsistent lines of analysis. This would be a most undesirable and harmful effect.

The Court can instead reaffirm § 103 nonobviousness as the sole operative test of patentability. Such a pronouncement by the Court in this case, coupled with the rejection of inconsistent standards of patentability, should finally set the patent law on the course toward a uniform and reasonably predictable standard of patentability.

Respectfully submitted,

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APPENDIX

APPENDIX A

LAYING THE GHOST OF THE "INVENTION" REQUIREMENT* BY JUDGE GILES S. RICH

The Subject

I am going to discuss §103 of Title 35 United States Code, the 1952 Patent Act, the unobviousness provision, because it is the heart of the patent system and the justification of patent grants. Why do I say that? For two reasons: *First*, it is §103 which brings about statutory *compliance with the Constitutional limitation* on the power of Congress to create a patent system, assuming novelty of the invention, of course, which is also necessary. (35 USC 101 and 102.) *Second*, it is the provision which assures that the patent grant of exclusive right is *not in conflict with the anti-monopoly policy* brought to this country from England by the colonists, long before our antitrust statutes, and that patent rights do not conflict with the policy of those statutes, which is to prevent odious monopolies and unreasonable restraints of trade.

Both compliance with the Constitution and avoidance of conflict with antimonopoly principles involve the same considerations: promoting progress in the technological arts while not interfering with the free use of technology which is fairly in the public domain. As I hope to make clear, §103 assures this result by allowing exclusive rights to inventors only when their inventions would not have been obvious to the ordinary workers in the field, preserving inviolate the common fund of technical knowledge which is obvious to the workers in the art. A time-limited exclusive right to subject matter which was neither known, nor obvious from what was known, *takes nothing from the public which it had before*. As a necessary corollary, the disclosure in a valid patent gives to the public knowledge it did not possess, actually or potentially, and thereby makes for progress.

It is worth remembering, furthermore, that we had a statutory patent system in this country for a century before we had a statute against monopoly. Antitrust law, therefore, should be so construed as to maintain a viable patent system. The 1952 Patent Act did sev-

*Substance delivered as a speech to: Los Angeles Patent Law Association Sept 18, 1972; San Francisco Patent Law Association Sept. 20, 1972; New Jersey and Philadelphia Patent Law Associations and Patent Section N.J. State Bar, October 12, 1972.

eral things to draw the line between patent rights and established anti-monopoly principles. The enactment of §103 was one of those things.[1]

I have written on this subject before and discussed it in innumerable opinions, as have my colleagues—long before the question got to the Supreme Court in 1966. In 1964 I wrote that I was discussing this subject because it was "the one I think causes the most trouble, the clarification of which I therefore believe would do the most good."[2]

In 1966, I felt that the Supreme Court had quite successfully clarified it. I am discussing it again because I and many others see that confusion remains rampant in the courts and has arisen even in the Supreme Court, which fact is creating even more confusion in the lower courts. It all seems so unnecessary and it is damaging to the patent system and discouraging to inventors, to whom we owe much, and that is bad for the country. It is even more discouraging to those who risk the investment to perfect and commercialize the inventions the inventors made and thus give the benefit of them to the public. Lawyers may thrive on confusion but businessmen like to know where they are at. Confusion in the law costs them money. That cost they pass on to the public.

So, once again, I address myself to the problem I think causes the most trouble in the sincere hope it may do some good.

I am not discussing §103 theoretically or on the basis of research into its "legislative history," as a young lawclerk would do today, twenty years after its enactment. I am doing it as one of its authors and, I believe, as the originator of one of its principal features. I hope a little of what I say will be remembered, because we who wrote it are gradually becoming an extinct species.

Of course, there are legal philosophers who would say it makes no difference what the authors intended, that §103 means what the courts say it means. Well, that is unhappily true. But what the courts are saying is conflicting and often wrong. While I live I shall therefore continue to tell the world what §103 was intended to mean and intended to do. Judge Learned Hand knew in 1955. My court found out in 1956 and has consistently acted on that knowledge

[1]Another one was the enactment of 35 USC 271(b) through (d) dealing with the case law problems of contributory infringement and patent misuse.

[2]"The Vague Concept of 'Invention' as replaced by §103 of the 1952 Patent Act," IDEA, Vol. 8 Conf. Number 1964, p. 136.

for sixteen years. The Patent Office has changed its practice accordingly. The Supreme Court found out in 1966 and approved. Yet today, although, according to the authors of *Patent Law Perspectives*, "each circuit in the United States has at least one case which properly comprehends the meaning of nonobviousness,"[3] opinions continue to issue in most circuits showing misunderstanding, confusion, and inconsistency. We have been in a state of transition in thinking for twenty years now, since the Patent Act of 1952, and it is high time we had uniformity of interpretation. My hope is to promote it.

The History

I think the best approach to a discussion of §103 is historical, to show what happened and why.

The United States patent system begins with the Constitution, behind which were centuries of foreign experience with inventions, monopolies, and patents that I shall skip. The Constitution empowered Congress to grant exclusive rights to inventors for their discoveries in order "to promote the progress of *** useful arts." *That is all it did and all it says on the subject.* Patents were the known way of granting exclusive rights.

The first Congress passed the first patent act in 1790. Under it patents were granted after a preliminary inquiry into patentability by a board. It was a pretty high-powered board. Thomas Jefferson was a member. By 1791 he had discovered that something was missing from the law; too many people were trying to patent trifles. So he proposed an amendment adding as a defense to a patent that "The invention is so unimportant *and obvious* that it ought not to be the subject of an exclusive right."[4] His proposal was never enacted—not for 161 years anyway.

Within three years the examination system as set up under the first patent act proved unworkable and the Act of 1793 was passed under which we went to a registration system for forty-three years. That too was unworkable and by the Act of 1836 we established the Patent Office and set up the essential features of our present examination system, under which applications for patent are examined against the prior art, as collected and classified by the Patent Office.

[3]Pat. L. Persp., 1972 Dev. §A.1[1]-63

[4]The Writings of Thomas Jefferson, 1788-1792 at 279, P.L. Ford Ed., Vol. 5 (1895). See Rich, *Principles of Patentability*, 28 Geo. Wash. L. Rev. 393, 403 (1960). For more on Jefferson see Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966), part II.

Still, the statutory law required only that the invention be new and useful and provided no *qualitative* measure of patentability for new inventions. Such a measure, though undoubtedly lurking in the law from an earlier time, was firmly grafted onto the statute in the form of case law by the Supreme Court in 1850 in *Hotchkiss* v. *Greenwood*, 52 U.S. 248, the famous doorknob case in which the court approved a charge to a jury that if the patented doorknob required "no more ingenuity or skill than was possessed by an ordinary mechanic acquainted with the business," the patent on it was invalid. The court further said that in such case the improvement was "the work of the skilled mechanic, not that of the inventor." Remember, the Constitution empowered Congress, if it wished, to secure exclusive rights to "inventors," not to just anyone. So, I suppose, that *could* be said to be a Constitutional limitation and that a "standard of patentability" is in the Constitution in that sense. But it should be obvious to any schoolchild that merely *calling* something an "invention," or its creator an "inventor," is no *standard* at all. It is merely a label, indicative of a judicial decision otherwise arrived at.

Another approach to finding a "Constitutional standard" seems to be based on the inherent limitation on the power delegated to Congress which is found in the words "To promote the progress of *** useful arts," which reasonably means that the conditions *Congress* imposes on the granting of exclusive rights to inventors must be such as will achieve that stated purpose. Since Congress does not grant the patents—the exclusive rights—but merely passes laws under which the administrative branch of the government grants them, it is the *laws* which must operate to achieve the purpose. In other words, the patent *system* Congress creates must achieve the purpose. This, clearly, is a limitation on the kind of system Congress can create. The gist of *Hotchkiss* v. *Greenwood* is that the Supreme Court, like Jefferson, sensed that Congress had not included in the statute a necessary limitation on the grant of patents and added that condition itself. This was judicial legislation. The Court added a *condition* but, as it turned out, it was not much of a standard, because it was too vague. The condition, as refined and sharpened in §103, creates a statutory system under which all patents granted pursuant to statute do serve to promote the progress of useful arts because, being for unobvious subject matter, they necessarily add to the sum of useful knowledge.

In any event, for the century following *Hotchkiss* v. *Greenwood* we had what was called the "requirement for invention," which, I emphasize, we have *not* had for the past twenty years. Instead we have §103.

The requirement for "invention" was at one and the same time a hard reality and a great mystery. Really, it was an absurdity. To be patentable, courts said, an invention had to involve "invention." If one asked for an explanation, the answer was, as the Supreme Court had pontifically announced in *McClain* v. *Ortmayer*, 141 U.S. 419, 427, in 1891, that "Invention cannot be defined." Only experienced patent lawyers, the Patent Office and judges knew what "invention" meant. You knew it by intuition, presumably from experience which, of course, judges passing on its presence or absence did not always have. The essence of being a patent lawyer or examiner—or a judge in a patent case—was to know an invention when you saw one yet there was no formal ordination. It was as easy as becoming a bird watcher. Judges, ex officio, were instant experts on the question.

As is usual with a doctrine derived from a court opinion, the doctrine persists and evolves while the facts of the case are forgotten. The words of the opinion of the first case are quoted in a second and embroidered upon, quoted again, and again reembroidered until after a century you have quite a body of so-called "law," or more properly *lore*, on the subject. Learned Hand, one of the great patent judges, summed it all up in 1955, saying to a Senate committee: "You could find nearly anything you liked if you went to the opinions. It was a subject on which judges loved to be rhetorical. *** patent lawyers *** like to quote all those things. There are lots of them." But, he said, "They never seemed to tend toward enlightenment."[5]

I think the height of absurdity appears in what is supposed to be our leading textbook, Walker on Patents, first Deller edition (1937, Vol. 1, p. 110): "An invention is the result of an inventive act." Various cases I could cite were equally mystical in explaining that patentable invention or just "invention" results from the exercise of the inventive faculty, creative skill, or inventive effort. One leading New York lawyer who had the temerity to argue to the Supreme Court in 1941 that the statute required only novelty and utility, which was so, and that the courts could not require more, was rewarded with an opinion which drove patent lawyers up the wall saying that to be patentable an invention had to be the result of a "flash of creative genius." (*Cuno Eng. Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84, 91.)

Since these conditions endured for over a century, the literature of

[5]Hearings pursuant to S. Res. 92, 84th Cong., 1st Sess., on the American Patent System, Oct. 10-12, 1955, p. 113, conducted by Senator O'Mahoney, Chairman, Subcommittee on Patents, Trademarks and Copyrights of the Committee on the Judiciary.

patent law, the textbooks, the articles, the cases, are all saturated with talk about this requirement for "invention" or the "standard of invention" required to validate a patent. Nobody talked or thought in any other terms, though they were not definitive. What it all came down to, in final analysis, in the Patent Office or in court, was that if the Office or a judge was persuaded that an invention was *patentable* (after hearing all the praise by the owner and all the denigration by the opposition) then it *was* an "invention." How that decision was reached was rarely revealed. Everyone realized it was subjective.

Consequently, the requirement for "invention" became the plaything of the judiciary and many judges delighted in devising and expounding their own ideas of what it meant. This kind of mystical reasoning left the judiciary free to indulge their personal whims about patentability. Notwithstanding what the Supreme Court has said,[6] we went through periods of too much leniency and too much strictness, depending primarily, just as now, on what judges thought and the mood of country.[7]

In the depression and post-depression thirties and forties we were going through one of the strict periods. Pressure began to build up to curb the courts by statute. Some bills were introduced. Just at that time the Congressional committee in charge of codifying the various titles of the U. S. Code decided it would be a good idea to codify Title 35, the patent law. That enterprise got under way through what was called the Coordinating Committee, a group of about 30 lawyers from private, corporate, and government practice, which worked with the House subcommittee. I was a member of the Coordinating Committee and of its small Drafting Committee.

[6]"The standard has remained invariable in this court." *Graham* v. *John Deere Co.*, 383 U.S. 1, part V of opinion, last par. In the hearings referred to in note 5, supra, the synopsis of hearings, at page XX, reports as follows:

> Judge Hand stated that in the second circuit the judges have been frank to admit that within the last several years the Supreme Court has adopted a very much stiffer rule about what is invention, and this tendency has become more and more fixed.

[7]The shifting of attitudes by the courts was not limited to the question of what did or did not constitute "invention." As anyone familiar with the history of the development of patent law knows, through the years there were radical shifts in views on what the patent right encompassed. Compare, for example, *Henry* v. *A. B. Dick Co.*, 224 U. S. 1 (1912) with *Motion Picture Patents Co.* v. *Universal Film Mfg. Co.*, 243 U. S. 502 (1917) which expressly overruled it, each opinion being by a divided court. Compare also *Leeds & Catlin Co.* v. *Victor Talking Mach. Co.*, 213 U. S. 325 (1909), with *Carbice Corp. of America* v. *American Patents Dev. Corp.*, 283 U. S. 27 (1931), and *Mercoid Corp.* v. *Mid-Continent Investment Co.*, 320 U. S. 661 (1944). More recent shifts from what were considered established prerogatives of patentees are exemplified in such cases as *Lear* v. *Adkins*, 395 U. S. 653, 162 USPQ 1 (1969), and *Blonder-Tongue Labs., Inc.* v. *Univ. of Illinois Foundation* 402 U. S. 313, 169 USPQ 513 (1971). Currently, patent law seems to have no more stability than quicksand.

The time is now December 1950. The Coordinating Committee was then working over a draft patent act prepared by Mr. Federico of the Patent Office. In it was a section (§23, Committee Print) which, after revision, became §103. It was intended to put something in the statute to take the place of the purely case-law requirement for "invention" and it was based on several suggestions. It was an unobviousness provision, but, typical of the habitual thinking of the time, it was entitled "Conditions for patentability, lack of invention." As is now well known, the Drafting Committee forthwith changed the phrase "lack of invention" to "non-obvious subject matter."

In December 1950 the bar was far from unanimous in thinking that the statute should deal with the requirement for "invention," not even the members of the Committee agreed. There are always those who prefer the *status quo*, with which they have learned to live, no matter how ridiculous it may be. Now, it is very significant that what persuaded the Coordinating Committee to replace the case law with a statutory provision was the Supreme Court's opinion, and Mr. Justice Douglas' concurring opinion, published in the New York Times on the very day in 1950 the Committee was having a meeting, in the case of *The Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 87 USPQ 303, (the "A&P" Case on the checkout counter). I am sure that is so because I remember reading the opinions aloud that day to the Drafting Committee. The *decision* may have been all right, but we considered what was said in the opinions to be typical of all that was wrong with the patent law's "invention" requirement.

I hope you note that I distinguish between decisions and opinions. It is very necessary to do so in the *stare decisis* system we have. What is it that is to stand, the decision on the facts before the court or everything it said? Many a sound *decision* is rationalized by atrocious reasoning in the *opinion*, often written by someone who does not know what he is talking about or what his words may be doing to the law. And that is where most of our trouble comes from today.

Let me now sum up for you the essential reasoning of the majority opinion in *A & P* which we determined to replace with a statute that hopefully made more sense. And my position is that Congress, enacting the Patent Act of 1952, *did* replace the *A & P Case* reasoning—not its decision on the facts—by substituting statutory for case law.

The *A & P* majority opinion found that the error of the District Court was that it found as a "fact" that *the invention was an inven-*

tion. The error of the Court of Appeals was that it, too, *perceived invention in the invention*. The problem the Court posed for itself was this:

> What indicia of invention should the courts seek in a case where nothing tangible is new, and invention, if it exists at all, is only in bringing old elements together?

That is to say, *the* invention before the Court was a combination—which practically all inventions are—and the *elements* of the combination all happened to be old, as elements usually are. The *combination* was *new*, but the Court apparently did not consider a new combination to be "tangible," which is like saying the *parts* of your watch are tangible, but the watch itself, as a distinct entity, is not. The Court's first big step toward solving its problem was to say:

> It is agreed that the key to patentability of a mechanical device that brings old factors into cooperation is the presence or lack of invention.

It then said that the invention must be examined for "invention"; that "The concept of invention is inherently elusive"; that courts must be cautious in affirmative definitions or rules on the subject. It found no "unusual or surprising consequences" from the new checkout counter at bar; that each element of the combination did only what one would expect it to do (which is what the gears, jewels, and hands of your watch do, or the transistors, capacitors, inductances, resistors and wires of your radio do); and that though the invention was "a good idea" it just wasn't patentable. The only defect which the Supreme Court could find in the concurring validity findings of the lower courts was

> ••• that a standard of invention appears to have been used that is less exacting than that required where a combination is made up of old components. It is on this ground (the court said) that the judgment below is reversed.

That reasoning is what clinched the decision to enact a statutory substitute that would make more sense, would apply to all kinds of inventions, would restrict the courts in their arbitrary, *a priori* judgments on patentability, and that, above all, would serve as a uniform *standard of patentability*. And so we come to 35 USC 103.

The Anatomy of §103

The first policy decision underlying §103 was to cut loose altogether

from the century-old term "invention." It really *was* a term impossible to define, so we knew that any effort to define it would come to naught. Moreover, it was felt that so long as the term continued in use, the courts would annex to it the accretion of past interpretations, a feeling history has shown to be well founded.

So §103 speaks of a condition of *patentability* instead of "invention". The condition is *unobviousness*, but that is not all. The unobviousness is *as of a particular time* and *to a particular* legally fictitious, technical *person*, analogous to the "ordinary reasonable man" so well known to courts as a legal concept. To protect the inventor from hindsight reasoning, the time is specified to be *the time when the invention was made*. To prevent the use of too high a standard —which would exclude inventors as a class and defeat the whole patent system—the invention must have been obvious at that time to "a person having *ordinary* skill in the art to which said subject matter (i.e., *the* invention) pertains." But *that* is not all; *what* must have been obvious is *"the subject matter as a whole."* That, of course, is the invention as defined by each patent claim. If, for example, a *combination* is claimed, §103 requires that to invalidate the claim, it must be shown that the *combination* was obvious, not merely its components.

As compared to finding or not finding "invention," §103 was a whole new way of thinking and a clear *directive* to the courts to think that way. Some courts and some lawyers do not yet seem to realize that.

Section 103 in the Courts—The "Codification" Question

Section 103 was sprung on a mentally unprepared world accustomed to thinking in terms of the requirement of "invention." After January 1, 1953, when the new patent act took effect, Courts by the dozen went merrily on in their old way invalidating patents for lack of "invention" and sustaining them because they found it. This I must blame in part on the lawyers who were also going merrily on in their old way, thinking and arguing on the basis of the old precedents. Some of them still do.

The first thing observable in the post-'53 cases was that many courts ignored §103 altogether, buying the argument that it was merely a "codification" of the old requirement, which they would therefore apply as they were accustomed to doing. They repeatedly held that no new test had been laid down. One of the troubles which hindsight now makes clear—but which was far from obvious at the

time—is that even we who wrote §103 did not fully realize the magnitude of the change in thinking §103 required—at least we did not realize it sufficiently to do a good job of selling it.

But there was at the time another reason for not trying to sell it as a major change which those who were not working on the project probably do not realize. The revision of Title 35 *was* primarily a codification project by a House codification committee and to get it enacted promptly without a long debate it had to be kept non-controversial. This had a profound effect on the way things were presented. It is not surprising, therefore, to find the House[8] and Senate[9] reports accompanying the bill, which were written primarily by Mr. Federico and which are almost identical, presenting §103 as placing in the statute a "condition" which, according to the reports, had "existed [in the law] for more than a hundred years" and as paraphrasing "language which has often been used in decisions of the courts"—which was literally true.[10] There were thousands of opinions on patentability *some* of which, like *Hotchkiss*, had in them ideas very similar to those in §103. But *A & P* was not such an opinion. The reports also say that "the section is added to the statute for uniformity and definiteness." Such statements and others made it arguable that it was just a "codification." But what does that mean? What is a codification? Do you follow the statute or ignore it; if you ignore it, why have it?

Codification is a loose term. It has been defined as the collection, condensation, systematizing and *reconciling* of what is scattered or *contradictory*. Yes, Title 35 as a whole is a codification; but it is also specifically and officially described as a codification *and revision*. An example of strict codification of case law is §102 (e) which put the rule of the *Milburn Case*, 270 U.S. 390 (1926), into the statute without change. An example of an outright change in prior law—revision—is §102 (d) under which a foreign patent granted on an

[8]82d Cong., 2d Sess., House Report No. 1923 to accompany H.R. 7794.

[9]82d Cong., 2d Sess., Senate Report No. 1979.

[10]Both the House and Senate reports contain this statement (p. 5 of House report and p. 4 of Senate report):

> Although the principal purpose of the bill is the codification of title 35, United States Code *** there are a number of changes in substantive statutory law. ***The major changes or innovations in the title consist of incorporating *a requirement for invention in section* 103 and the judicial doctrine of contributory infringement in section 271.

The emphasis is mine and I cite this as a prime example of the difficulty even some of those most intimately involved had in shaking off old ways of thinking and of expressing themselves. Section 103 was not a requirement "for invention," it was a substitute for it as the reports made clear in the discussion of §103 on p. 7 of the House Report and on p. 6 of the Senate Report.

application filed more than a year before the U. S. application bars the U. S. patent only if it issues before the U. S. *application* is filed, whereas formerly it was a bar if issued before the U. S. *patent* issued. Section 271 (a) is straight codification or restatement of existing case law which was entirely clear. But §271 (b)-(d) is codification of another sort altogether. A controversy had been raging in the courts over contributory infringement and misuse and these paragraphs were designed to put an end to it and to overrule certain decisions. Section 103 was of a similar nature except that the situation was different. It was a new statement of an old requirement of the law which was utterly uncertain and indefinite. The statute undertook to remove ambiquity and provide definiteness. Calling that a "codification" proves nothing. In the hope of making clear what §103 did, I will reformulate what I said about this in 1964:[11]

When, as was the case with the "requirement for invention," the century's accumulation of judicial precedents range from A to Z in strictness and Congress, looking at the situation under the guiding light of Kettering's statement that *this is no yardstick and the greatest technical weakness of the patent system*, determines to make a yardstick and says the measure shall be "M", right in the middle of the range, it behooves everyone concerned with administering that law to follow the measure "M" and to stop flitting about arbitrarily from A to Z, ignoring what Congress has done.

Hopefully, that clears up the "codification" question. Whatever you call it, the purpose was to substitute §103 for the requirement of "invention" and for all prior case law, including the *A & P Case*, even though *some* cases contained the same principles. It was to be statutory, not case law in the future.

On the point of §103 being "codification" it is interesting to consider the last sentence of the section which says "Patentability shall not be negatived by the manner in which the invention was made." The specific intent of that sentence, which courts universally accepted without question, was to overrule the *Cuno* case dictum that a "flash of genius" was necessary. One cannot call that "codification."

As above indicated, for the first few years courts were not heeding the statute, largely, I think, because the bar was not doing so. Judges tend to get the law from the winning party's brief. The very first judicial recognition of what was intended by §103 was Judge Learned Hand's opinion for the Second Circuit Court of Appeals in *Lyon* v. *Bausch & Lomb*, 244 F.2d 530, 106 USPQ 1, in 1955. He

[11]IDEA, Conf. No. Vol. 8, p. 145.

also understood the underlying reason for §103. He correctly stated in *Reiner v. I. Leon*, 285 F.2d 501, 128 USPQ 25 (1960), that it was "to change the slow but steady drift of judicial decision that had been hostile to patents •••".

When I came to the C.C.P.A. in 1956, three and a half years after §103 came into effect, I found it being totally ignored. That is not too surprising. The court was dealing with office actions several years old rejecting claims for lack of "invention" and the appellants' briefs, like those of the Patent Office Solicitor's, were still couched in those terms. It was probably in my first conference that I suggested that for some time we had had a statute that had put patentability on another basis which we should follow. One of the judges was incredulous. He said, "I thought if it is an invention it is patentable. Do you mean to say you can have an unpatentable invention?

Well, I can say again, what I said then; anyone who has ever made a search of the prior art to determine whether a client's invention is new knows that many inventions turn out to be old and hence unpatentable. They do not cease to be inventions because they have been made before. As I sometimes remind attorneys arguing cases, There is always *an* invention. What we are considering is its *patentability*."

Through the ensuing years that kind of thinking has totally disappeared in our court—but not everywhere. The persistence of the C.C.P.A. in following the statutory test gradually brought the Patent Office into line and after a few years I was told that the Patent Office Academy, which trains examiners, had swept the requirement for "invention" under the rug. We now rarely see a rejection in those terms in a record. But it was a slow transition.

Section 103 Reaches the Supreme Court

The Great Event, of course, was the Supreme Court's 1966 entry into the arena in *"The Trilogy"*, generally identified by the title *Graham* v. *John Deere* and including *Calmar* v. *Cook* and *United States v. Adams*, 383 U.S. 1, 39, 148 USPQ 459, 479. That was thirteen years after the effective date of the 1952 Patent Act.

All things considered, §103 fared well in the *Trilogy* from the point of view of its authors. It was held to be a constitutional exercise of legislative power. It was accurately construed in those two now familiar sentences (383 U.S. at 17):

> Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

Except for the last step, determination of nonobviousness, which is a question of law and the ultimate determination of the court, these are factual inquiries, subject to proof by evidence. The first two, determination of the prior art and the differences from it which exist in the invention, are relatively easy to determine and prove with exactness. Level of ordinary skill is more difficult, more of a value judgment. Here is where judges have trouble and where they need help. Where do they get it? Well, maybe they will get some opinion testimony which isn't very persuasive; but the *best* evidence and the *most reliable* may be the *circumstantial* evidence.

"Secondary" or Circumstantial Considerations

If a man is observed coming away from the scene of a murder with a bloody knife or a smoking pistol, the evidence thereof may be more convincing than what he says. So it is if a competitor suddenly gives up his way of doing things and switches to the invention or, as in the *Adams Case* of the *Trilogy*, after pooh-poohing the invention and reporting that it won't work, the defendant adopts it and uses it successfully on a large scale. Well, what did the Supreme Court say about such evidence? It said (383 U.S. at 17-18):

> Such secondary considerations as commercial success, long felt but unresolved needs, failure of others, etc., [please note the "etc."; these are but exemplars] might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

Well of course they *do* have relevancy and the Supreme Court itself applied them in the *Adams Case*.

There is just one unfortunate word in that passage: "secondary." I don't think it should be given any weight though some courts seem to have done so, in effect, first deciding obviousness by visceral reaction and then saying that, having decided the issue, it is no longer necessary to consider the evidence—the best evidence—on the issue. This would be hard to explain except that in patent law there was an old rule—which also made no sense—that in determining "inven-

tion" one took commercial success into account only in *doubtful* cases, to tip the scales when they were otherwise evenly balanced. I sense that courts or lawyers transported that old thinking into their dealing with §103. If commercial success and similar circumstantial evidence was considered only in doubtful cases in determining "invention," why not the same rule in determining nonobviousness?

I do not believe the Supreme Court intended to signify anything by the term "secondary." It could equally have said "other considerations." It cited a law review note entitled "Subtests of 'Nonobviousness' ", not "secondary" tests. I suggest that in thinking about those "considerations" they be looked upon for what they factually are" *circumstantial evidence of unobviousness of the highest probative value*, unless there is some other explanation for the action. As a judge, if I were presented with a defense of obviousness and the evidence showed that the defendant, long knowing about a problem in his product or his manufacturing process for which he had found no solution, changed over to use his competitor's patented invention as soon as he heard of it, I would not call that evidence "secondary" and ignore it in considering his argument that it was an obvious invention. I would think as did Learned Hand (*Safety Car Heating and Lighting Co.* v. *General Electric Co.*, 155 F.2d 937, 939) in 1946 that:

> In appraising an inventor's contribution to the art *** *the most reliable test* is to look at the situation before and after it appears. *** Courts, made up of laymen as they must be, are likely either to underrate, or to overrate, the difficulties in making new and profitable discoveries in fields with which they cannot be familiar; and, so far as it is available, they had best appraise the originality involved by the *circumstances* which preceded, attended and succeeded the appearance of the invention. *** We have repeatedly declared that in our judgment this approach is *more reliable* than a priori conclusions drawn from vaporous, and almost inevitably self-dependent, general propositions. (My emphasis).

Yet we have such ludicrous and self-contradictory court of appeals statements as this in *Westwood Chemical, Inc.* v. *Owens-Corning Fiberglas Corp.*, 171 USPQ 1, 6 (6th Cir. 1971):

> *** secondary indicia of nonobviousness are relevant and become supplementally useful only where there is a *close* question of whether the subject matter of an invention was obvious

> [citing two cases, one from another court of appeals]. These secondary considerations, *no matter how persuasive*, cannot save the patentability of an invention when it clearly appears, as in this case, that the invention was obvious to one skilled in the art. [My emphasis.]

How can anything be clear when even the most persuasive evidence is ignored? Until all the evidence has been considered, how does a court know it is a close question?

Here is an even later example in 1972, still harking back to the "invention" requirement, *Hewlett-Packard Co.* v. *Tel-Design, Inc.*, 174 USPQ 140, 144 (9th Circuit):

> We turn, then, to the secondary indicia of patentability relied on by the district court [which was reversed]. The district court found that the fact that the Anderson patent [meaning the Anderson invention] did not fail to fulfill a recognized need in the industry and enjoyed commercial success was at least important in the determination of nonobviousness. However, this court and others have repeatedly held that such secondary considerations cannot make patentable a patent [meaning an invention] which [patent] is invalid *for lack of invention*. Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 87 USPQ 303 (1950). [Emphasis added and citation of six more cases omitted.]

If courts cannot keep in mind the difference between an invention and a patent, it is perhaps not surprising that they cannot distinguish §103 from the old requirement for "invention." Understanding the terminology one is using is half way to clear thinking on most any subject. Lack of understanding is not compensated for by citation of precedents.

The most important question answered in *Graham* was whether §103 replaced "invention" as a test for patentability, so that it is legally dead. The answer is "Yes." The circumstantial evidence of this is that in the three cases of the *Trilogy* the Supreme Court applied no other test, deciding the validity of the patent in each case according to the obviousness inquiry specified in §103. But specifically the Court made these unequivocal statements after reviewing the evolution of the "invention" requirement and taking note of the variety of opinions as to its meaning which had evolved. These are the things the Court said (383 U.S.):

• • • •

> The section is cast in relatively unambiguous terms. (p. 14)

> Congress has emphasized 'non-obviousness' as the operative test of the section, rather than the less definite 'invention' language of Hotchkiss ***. (p. 14)
>
> • • • •
>
> *** the §103 additional condition, when followed realistically, will permit a more practical test of patentability. (p. 17)
>
> • • • •
>
> We believe that strict observance of the requirements laid down here will result in that uniformity and definiteness which Congress called for in the 1952 Act. (p. 18)

The Court then commented on the alleged discrepancy between the standards applied in the Patent Office and in the courts and critically observed that the discrepancy

> *** may well be the free rein often exercised by examiners in their use of the concept of 'invention'. (p. 18)

Finally, the Supreme Court opinion admonished both the Patent Office *and the courts*

> *** that the inquiry which the Patent Office and the courts must make as to patentability must be beamed with greater intensity on the requirements of §103***. (p. 19)

The Patent Office is no longer a problem but there are still courts that seem not to have gotten the word.

The Settled Becomes Unsettled

In concluding this discussion, I will say just a few things about the conventional wisdom regarding so-called "combination patents." This brings me to *Anderson's-Black Rock* v. *Pavement Salvage Co.*, 396 U.S. 57, 163 USPQ 673 (1969), and takes me back to the *A & P Case*. Space precludes a full discussion and it was all done in "After Black Rock: New Tests of Patentability—The Old Tests of Invention", by Mintz & O'Rourke, 39 Geo. Wash. L. Rev. 123 (Oct. 1970). I just want to give you my impressions of the kind of a mess we are in, why we are in it, how ridiculous it all is, and how simple the solution can be.

As I said, the two decades since 1952 have been a period of transition in thinking. A century of habitual and thoroughly imbedded thought about the mysterious "invention" requirement is being slowly but surely supplanted by the unobviousness requirement of

the statute and the process of inquiry there prescribed for its determination. But old ideas die hard. Pasteur had a difficult time persuading people germs caused disease and that germs did not result from spontaneous generation. We are still far from being shed of the "invention" requirement. A habit, after all, is a habit.

Three years after the *Trilogy* came *Anderson's-Black Rock. Patent Law Perspectives*, that unique, up to the minute, critical, professional and professorial review of current goings on in patent law, in the 1969-70 annual review (§A.1[1]-1), regards Justice Douglas' *Black-Rock* opinion as

> *** asserting the proposition that the doctrines of both *A & P* and the *Trilogy* are to be viewed as alive, vital and jointly operative as if they are cooperative legal entities rather than the essentially inconsistent propositions of law which they are.

Mintz and O'Rourke, *supra*, as young lawyers often do, overreact to *Black Rock* as undoing *Graham* and reverting to the old "invention" test. I do not see *Black Rock* that way and I do not believe any court carefully reading both opinions will do so either. The two opinions *are inconsistent*, at least in some of the language used, but *Graham* is the more carefully reasoned and *Black Rock* contains not one iota of criticism of *Graham*, from which it quotes approvingly. The language in *Black Rock* which people deplore obviously comes from a mind thoroughly steeped in the old "invention" lore and which has not succeeded in making a complete transition to the new statutory situation.

Much depends on where you put the emphasis. *Black Rock* says, after all,

> In this case the question of patentability of the combination turns on the meaning of 35 U.S.C. §103. (p. 61)
>
> We conclude that *** the use of the old elements in combination was not an invention by the obvious-nonobviousness standard. (p. 62)

That is not absolute heresy even to an author of §103. If it had said it was not *a patentable* invention instead of not "an invention" it would have been unexceptionable. The summary conclusion of the Court was that "the combination was reasonably obvious to one with ordinary skill in the art." To say in addition that the combination was not an invention is a bit superfluous and also a bit old fashioned.

Now what was the dictum in *Black Rock* that bugs people? Well, it was the very idea expressed in *A & P* which stimulated the enactment of §103 to supplant it, but which, unhappily, is still current dogma in some courts, namely, that inventions which are a combination of old elements must be tested for patentability (formerly for "invention" now for unobviousness) by an extra severe test—more severe than the test for inventions of other kinds. *A & P* spoke of the "difficulty and improbability of finding invention in an assembly of old elements" and said the whole must in some way exceed the sum of its parts to produce unusual or surprising consequences. That is the "severe test." It was indeed severe—it was an impossible test, so §103 was enacted to replace it.

Justice Douglas in *Black Rock* looked for a "synergistic result" by which he seems to have meant an effect greater than the sum of the several effects of the elements of the combination taken separaely. I suggest to the reader that he look up "synergistic" in the dictionaries.

Congress in §103 threw down the gauntlet to these notions by substituting a different test—the obviousness test—applicable to all inventions alike. Since then no justification can be found for treating one kind of invention differently from another.

There is a enormous flaw in the reasoning supposed to underlie the *A & P* test, however, in that almost *all* inventions are combinations of elements, generally all old elements. This is not a new idea. Learned Hand said it in 1960, *Reiner* v. *I. Leon*, supra. Even Dr. Glen Seaborg's new trans-uranium *elements*, which the C.C.P.A. approved patenting in 1964 (*In re Seaborg*, 51 CCPA 1105, 1109, 328 F.2d 993, 996, 140 USPQ 659, 662) were new combinations of old components—protons, electrons, and the like. New chemical compounds, which pass through our court in a steady stream, are combinations of necessarily old elements, all of course known, rearranged in new molecules.

As for synergism, I don't know what Justice Douglas meant by it as applied to mechanical devices. Etymologically the term derives from the Greek, *syn*, together, and *ergon*, work; working together, which the parts of all mechanical devices do. Outside the courts, the term is not used in the field of mechanics, but rather in the chemical field where a synergist is a material which enhances the remedial efficiency of a therapeutically active agent or the effectiveness of an insecticide or similar biological agent. But even if we look at the mechanical field and try to apply the plain meaning of synergism—working together—does it mean anything more than that two men on a rope can move a load neither can budge alone, that rope and pulleys combined enable one man to lift more than he can lift alone, and that a wedge and a sledge will split a log which neither will do alone? Is the concept any more esoteric than that soap and water produce results neither produces by itself? Unless synergism is so interpreted, I doubt that any trial lawyer, ever, is going to be able to meet the "strict test" implicit in the following two unfortunate sentences of *Black Rock* dictum:

> A combination of elements may result in an effect greater than the sum of the several effects taken separately. No such synergistic result is argued here. (p. 61)

The laws of physics and chemistry in accordance with which all inventions perform do not permit of the judically imagined magic accordingly to which 2+2=5. Wherever such a spurious test prevails all patents are invalid. And there are those who think that is heaven.

I do not believe the Supreme Court sees the inconsistencies between *Graham* and *Black Rock* that get patent lawyers so excited and I think that if it ever has to resolve the matter it will stick with *Graham* and say—for face-saving reasons—that *Black Rock* is really to the same effect.

I remember how the bar got so excited about the flash-of-genius case—*Cuno*, supra, cigar lighter, 1941, opinion by Mr. Justice Douglas, two justices concurring in the result—and how in the very next case, *Sinclair & Carrol*,[12] printing ink, 1945, opinion by Mr. Justice Jackson, Justices Douglas and Black concurring in the result, the Court effectively backed down saying it was "not concerned with the quality of the inventor's mind, but with the quality of his product." The Court is not going to admit to inconsistency if it can help it, witness *Graham's* impassioned insistence that for over a century the Court has applied exactly the same standard of patentability. Who can prove it hasn't?

What do you do with such a situation? There is no finer example of what to do than what the Ninth Circuit Court of Appeals did last year in *Reeves Instrument Corp.* v. *Beckman Instruments, Inc.*, 444 F. 2d 263, 170 USPQ 74 (1971). It applied §103 in accordance with its terms and the reasoning of *Graham;* it answered the argu-

[12] *Sinclair & Carroll Co.* v. *Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945).

ment that the patent was invalid for failure to meet the *A & P* test by saying that that contention suggests an analytical approach directly contrary to §103 which, carried to its logical conclusion, would preclude the patenting of virtually every mechanical or electrical device since they are all combinations of old elements; it reduced *Black Rock* to its proper size by ignoring the rhetoric and regarding it merely as a simple obviousness decision coupled with a reaffirmation of *Graham;* and, finally, it treated the factual evidence of the "secondary considerations," referred to in *Graham,* as of primary importance demonstrative of unobviousness under §103:

Patent Law Perspectives[13] called the *Reeves* opinion "One of the finest judicial treatments of the law of nonobviousness ever written •••." Now that is another kind of heaven.

Dum spiro, spero![14]

[13] I am told the publisher is about to supply copies of this publication gratis to all Courts of Appeal and a dozen or so District courts with heavy patent dockets.

[14] "While I breathe, I hope!" (Editor's note)